

REMARKS

Reconsideration and allowance of the above-referenced application are respectfully requested in light of the above-marked amendments and the foregoing remarks. The Examiner is encouraged to contact the undersigned at +1.858.314.1535 or cakukkonen@mintz.com to discuss this Response.

Rejections under 35 U.S.C. §103

Claims 78-80, 84, 85, 87-97, 99-107, 111, 112, 114-124 and 126-142 stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over U.S. Patent Application Publication No. 2003/0069869 to Gronau et al. (hereinafter “Gronau”) in view of U.S. Patent No. 6,411,936 to Sanders (hereinafter “Sanders”) and U.S. Patent Application Publication No. 2004/0039619 to Zarb (hereinafter “Zarb”). Claims 98 and 125 stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Gronau in view of Sanders, Zarb, and U.S. Patent Application Publication No. 2002/0147626 to Zagotta et al. (hereinafter “Zagotta”). These rejections are respectfully traversed.

As required by the Supreme Court, a proper rejection under 35 U.S.C. §103 requires determining the scope and contents of the prior art and ascertaining the differences between the prior art and the claimed subject matter, and resolving the level of ordinary skill in the pertinent art to determine if the differences would have been within this level of ordinary skill. *Graham v. John Deere*, 383 U.S. 1, 148 USPQ 459 (1966), reaffirmed in *KSR v. Teleflex*, 550 U.S. 398 (2007). As noted in MPEP §2141.02 and §2143.03, this analysis further requires consideration of whether the claimed subject matter as a whole would have been obvious to one of ordinary skill in the art at the time of invention. *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 218 USPQ 871 (Fed. Cir. 1983); *Schenck v. Nortron Corp.*, 713 F.2d 782, 218 USPQ 698 (Fed. Cir.

1983). Merely distilling the claimed subject matter down to the “gist” or “thrust” of an invention disregards this requirement. *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984). All words in a claim must be considered in judging the patentability of that claim against the prior art. *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). Thus, if the cited references fail to disclose or at least fairly suggest each specific and explicit limitation of the claimed subject matter, the Office can present a valid *prima facie* case for obviousness under 35 U.S.C. §103 only by presenting a convincing line of reasoning as to why one of ordinary skill in the art at the time of conception of the instantly claimed subject matter would have found the claimed invention to have been obvious in light of the teachings of the references. See *e.g.* MPEP §706.02(j) citing *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985).

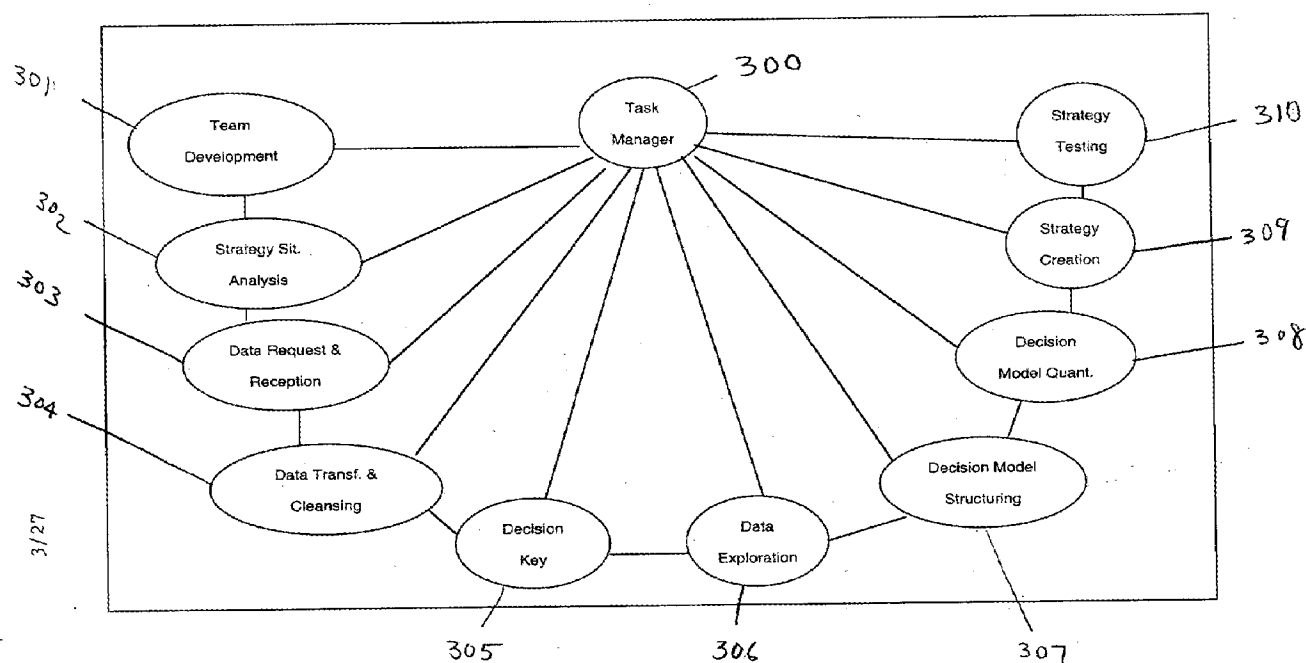
Remarks for independent claim 105 and associated dependent claims:

Claim 105 recites, inter alia, the following feature: “wherein each module of the plurality of modules occurs once in a predetermined sequence of the plurality of modules, wherein output of each module of the predetermined sequence is an input of a next module in the predetermined sequence until control is passed to a last sequential module in the predetermined sequence, wherein each module of the predetermined sequence interacts with an expert task manager, wherein said expert task manager provides expert knowledge about strategy modeling processes to the modules.”

Claim 105 requires a plurality of modules including a team development module, strategy situation module, data request and reception module, data transformation and cleansing module, decision key and intermediate variable module, data exploration module, decision model structuring module, decision model quantification module, strategy creation module, and strategy

testing module. Refer to original application at least at Fig. 3 (reproduced below), TABLE C, and associated text. As noted in the original application at Fig. 3, the plurality of modules occur in a sequence such that each module *occurs once* and that output of each module is an input of the next module until control is passed to the last module (e.g. strategy testing module 310). Emphasis added.

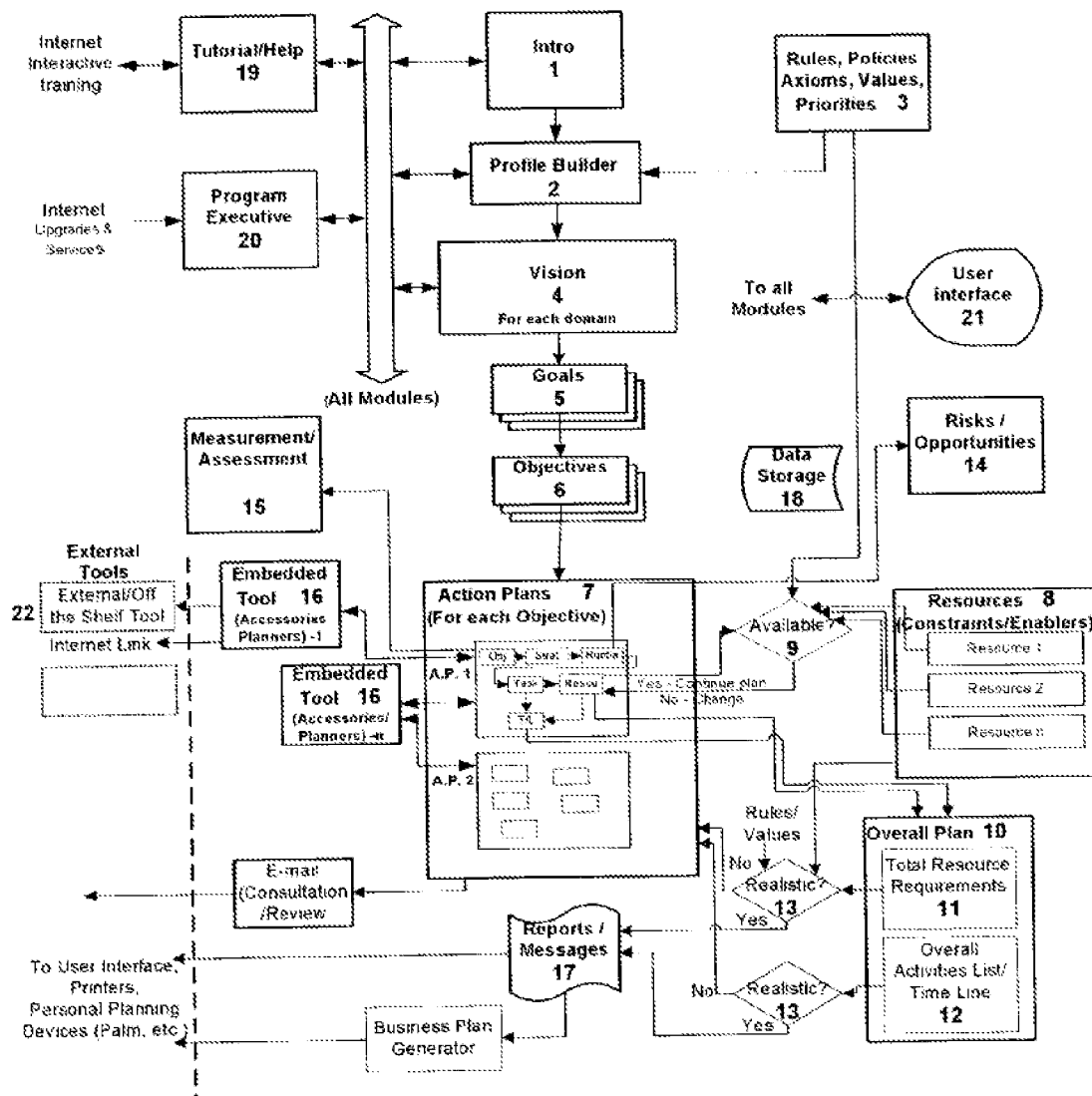
Fig. 3



Original application at Fig. 3

In contrast to claim 105, Gronau describes an enterprise performing a series of steps 1-22 on an application to perform strategic planning by using a strategy plan. For example, see Gronau at FIG. 1 (reproduced below). The strategy plan constitutes optimum allocation of resources available in a resource database. To perform the strategic planning, the enterprise uses a profile builder to create a profile of the enterprise on the application. The profile consists of current financial information of the enterprise. Then, the enterprise defines rules (including policies, axioms, values and priorities) that need to be used to achieve the objectives. The

defining of the rules includes either (a) selecting the rules out of a predefined rules database, or (b) creating the rules, adding the created rules to the rules database, and selecting the added rules out of rules stored in the rules database. Subsequent to the above-mentioned defining of the rules, the enterprise defines, using the defined rules, objectives that need to be achieved. Based on the objectives, the available resources are assessed and allocated according to each corresponding objective. A measurement and assessment function keeps a track of status of activities and achievement of the objectives in the strategy planning process.



Gronau at FIG. 1

Throughout the Office Action, the Office asserts that Gronau's steps 1-22 (as noted above with respect to Gronau at FIG. 1) constitute the modules recited in claim 105. This assertion is respectfully traversed in view of the reasons that follow.

The Office relies on Gronau's assessment of available resources (steps 3 and 8) for the claimed team development module, relies on Gronau's development of vision and goals (steps 4 and 5) for the claimed strategy situation analysis module, relies on Gronau's defining and assessment of rules (steps 3 and 8) for the claimed data request and reception module, relies on Gronau's defining of rules (step 3) for the claimed data transformation and cleansing module, relies on Gronau's defining of rules (steps 3) for the claimed decision model quantification module, relies on Gronau's development of vision and goals (steps 4 and 5) for the claimed strategy creation module, and relies on Gronau's tracking status of activities by measurement/assessment function (step 15) for the claimed strategy testing module. Thus, the Office relies on each of some steps of Gronau at FIG. 1 for multiple claimed modules. As one example, the Office relies on Gronau's step 3 for at least the claimed team development module, the claimed request and reception module, and the claimed decision model quantification module. However, claim 105 requires that each module occur once in a predetermined sequence, rather than occur multiple times. Thus, even if Gronau's step 3 is assumed *arguendo* to constitute one particular claimed module, Gronau's step 3 cannot possibly be relied upon for other claimed modules, as such a reliance necessitates Gronau's step 3 to occur multiple times rather than *occur once*, as required by claim 105. Emphasis added.

In view of at least the point noted above, Gronau fails to disclose or suggest the following feature of claim 105: "wherein each module of the plurality of modules *occurs once* in a

predetermined sequence of the plurality of modules, wherein output of each module of the predetermined sequence is an input of a next module in the predetermined sequence until control is passed to a last sequential module in the predetermined sequence, wherein each module of the predetermined sequence interacts with an expert task manager, wherein said expert task manager provides expert knowledge about strategy modeling processes to the modules.” Emphasis added.

Further, the Office acknowledges on pages 5 and 6 of the Office Action that Gronau fails to disclose or suggest the claimed decision key and intermediate variable creation module 305 (refer to original application at Fig. 3 shown above), and the claimed data exploration module 306. To cure these deficiencies of Gronau, the Office relies on Sanders and Zarb. However, this reliance is respectfully disagreed-upon as follows.

Sanders and Zarb, whether taken individually or in combination, fail to cure the above-noted deficiencies of Gronau.

Moreover, claim 105 requires that that all modules occur in a predetermined sequence (e.g. sequence shown by original application at Fig. 3 shown above) such that until a last module of the sequence is reached, output of one module is an input to the next module. Accordingly, for an appropriate combination of Gronau with Sanders, the Office needs to show that the output of a module (e.g. data transfer and cleansing module 304) prior to the decision key and intermediate variable creation module 305 should be similar to input to the relied-upon alleged module in Sanders. Furthermore, for an appropriate combination of Gronau, Sanders and Zarb, the Office needs to show that the output of a module (e.g. decision key module 305) prior to the data exploration module 306 should be similar to input to the relied-upon alleged module in Zarb. However, it is believed that the Office has failed to provide the above-noted showings for

an appropriate combination of Gronau, Sanders, and Zarb. In view of at least this reason, it is incorrect to combine Gronau, Sanders, and Zarb for rejecting the features of claim 105.

In view of at least the reasons noted above, it is respectfully submitted that that a *prima facie* case for obviousness has not been established and claim 105 should be in condition for allowance. Therefore, claim 105 is allowable over Gronau, Sanders, and Zarb, whether taken individually or in combination, and the rejection under 35 U.S.C. §103(a) of claim 105, as well as claims 106, 107, 111-112, 114-124, and 126-131, at least by reason of their dependency, should be withdrawn.

Remarks for independent claim 132 and associated dependent claims:

Independent claim 132, although of different scope, includes features similar to those noted above with respect to claim 105. For at least this reason, claim 132, as well as claims 133-142, at least by reason of their dependency, are allowable over Gronau, Sanders, and Zarb, whether taken individually or in combination, and the rejection under 35 U.S.C. §103(a) of those claims should be withdrawn.

Additional remarks for dependent claims 133-142:

Further, claims 133-142 describe how modules of the claimed predetermined sequence are connected. For support, see original application at TABLE C, Fig. 3, and associated text. It appears that the Office has incorrectly relied on merely one element of Gronau (rather than separate elements in Gronau for reliance on separate claimed modules) at paragraph 52 for all the separate features recited in claims 133-142. For this additional reason, claims 133-142 are allowable over Gronau, Sanders, and Zarb, whether taken individually or in combination, and the rejection under 35 U.S.C. §103(a) of those claims should be withdrawn.

Remarks for Independent claim 78 and associated dependent claims:

Further, the Office argues in “Response to Arguments” on page 19 of the Office Action that claim language does not specify a specific sequence. The Office continues rejecting claims based on this argument, as it appears by reading the “Response to Arguments” on page 19 of the Office Action. However, it is submitted that claims 133-142 clarify this specific sequence. Thus, the modules occur in a specific sequence, as per claims 133-142. To expedite prosecution with respect to independent claim 78, claim 78 has been amended to incorporate some of the subject matter previously presented in claims 133-142, thereby clarifying the specific sequence of modules in the claimed predetermined sequence. This amendment to claim 78 obviates the basis of the rejection of claim 78. Additionally, claim 78 includes features noted above with respect to claim 105. In view of the above-mentioned points, claim 78 is allowable over Gronau, Sanders, and Zarb, whether taken individually or in combination, and the rejection under 35 U.S.C. §103(a) of claim 78, as well as claims 79, 80, 84, 85, 87-97, and 99-104, at least by reason of their dependency, should be withdrawn.

Claim 98 depends from claim 78 and includes all the features recited therein. Further, it is submitted that Zagotta fails to cure the above-noted deficiencies of Gronau, Sanders, and Zarb. Accordingly, claim 98 is allowable over Gronau, Sanders, Zarb, and Zagotta, whether taken individually or in combination, and the rejection under 35 U.S.C. §103(a) of claim 98 should be withdrawn for at least this reason.

Claim 125, although of different scope, includes features similar to those noted above with respect to claim 98. Therefore, claim 125 is allowable over Gronau, Sanders, Zarb, and Zagotta, whether taken individually or in combination, and the rejection under 35 U.S.C. §103(a) of claim 125 should be withdrawn for at least this reason.

Conclusion Comments

It is believed that all of the pending claims have been addressed in this paper. However, failure to address a specific rejection, issue or comment, does not signify agreement with or concession of that rejection, issue or comment. In addition, because the arguments made above are not intended to be exhaustive, there may be reasons for patentability of any or all pending claims (or other claims) that have not been expressed. Finally, nothing in this paper should be construed as an intent to concede any issue with regard to any claim, except as specifically stated in this paper, and the amendment of any claim does not necessarily signify concession of unpatentability of the claim prior to its amendment. Applicant asks that all claims be allowed.

If there are any questions regarding these amendments and remarks, the Examiner is encouraged to contact the undersigned at the telephone number provided below. The Commissioner is hereby authorized to charge any additional fees that may be due, or credit any overpayment of same, to Deposit Account No. 50-0311, Reference No. 35006-556F01US.

Respectfully submitted,

Date: April 6, 2012

/ck3/
Carl A. Kukkonen, III
Reg. No. 42,773

Address all written correspondence to
Customer No. 76615
Mintz, Levin, Cohn, Ferris, Glovsky and Popeo, P.C.
3580 Carmel Mountain Road, Suite 300
San Diego, CA 92130
Phone: 858.314.1500
Fax: 858.314.1501
Email: ckukkonen@mintz.com